

U.S.S.N. 10/654,761
Filed: September 4, 2003
RESPONSE TO OFFICE ACTION

Remarks

Claims 1-35 are pending. Reconsideration, and withdrawal or modification, of the election and restriction requirements are respectfully requested as detailed below.

Restriction Requirement

The Office Action divided claims 1-35 into two groups: Group I, claims 1-11, drawn to a method of delivering parathyroid hormone; and Group II, claims 12-35, drawn to an implantable device. Applicants elect, with traverse, to prosecute Group II, claims 12-35.

Applicants traverse because the claimed device and the claimed method of using the device define like devices, and the Examiner has not provided any evidence or well reasoned argument to support his contention that the particular method defined by the claims can be practiced with a materially different device. The example provided in the Office Action does not rationally support the contention of distinctness, because both the claimed method and device could be considered to be or to cover a "biodegradable controlled release substrate implant device" contrary to the Examiner's contention in the Office Action.

Species Election Requirement

The Office Action indicated that the claims are directed to the following patentably distinct species and requires election to a single species:

- Species I - Figures 1 and 1A
- Species II - Figures 2 and 2A
- Species III - Figure 3
- Species IV - Figure 4A
- Species V - Figure 4B
- Species VI - Figure 5
- Species VII - Figures 6 and 7

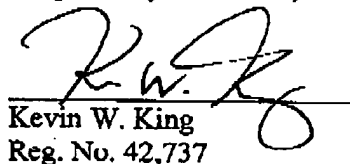
U.S.S.N. 10/654,761
Filed: September 4, 2003
RESPONSE TO OFFICE ACTION

Applicants elect, with traverse, Species II. Claims 12-25, 27, 28, 32, and 34 read on the elected species.

Applicants traverse on the grounds that it is unreasonable to consider these Figures to be representative of actual "species" given the readily ascertainable overlap among certain of the illustrated structures. For different embodiments within a genus to actually be distinct *species*, there should be no overlap among them. Furthermore, the Examiner is incorrect in asserting that no claim is generic; claim 12 is in fact generic to all of the so-called species.

Applicants respectfully request that the restriction requirement and the species election requirement be withdrawn and that examination of claims 1-35 proceed on the merits.

Respectfully submitted,


Kevin W. King
Reg. No. 42,737

Date: August 19, 2005
SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street NE
Atlanta, Georgia 30309-3996
(404) 853-8068
(404) 853-8806 (fax)